

### R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

### SUPPORT FOR CLAIM AMENDMENTS

Support for the amendments to the claims can be found in the drawings as originally filed, for example, FIGS. 1-4 and in the specification as originally filed, for example, on page 9, line 7 through page 11, line 18. As such, no new matter has been added.

### CLAIM REJECTIONS UNDER 35 U.S.C. §103

The rejection of claims 1-5, 7-12, 15-17, 19 and 21-23 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider et al. '629 (hereinafter Bretschneider) in view of Sartore et al. '103 (hereinafter Sartore) has been obviated by appropriate amendment and should be withdrawn.

Bretschneider is directed to a method and apparatus for automatically updating data files in a slide presentation program (Title). Sartore et al. '103 (hereinafter Sartore) is directed to a bus interface system and method (Title).

In contrast, the presently claimed invention (claim 1) provides (a) a first device configured to present one or more first control signals dedicated to advancing through a plurality of slides presented by an electronic presentation program in response

to one or more input instructions, where the first device is configured to operate according to a standard device driver provided in an operating system. Claims 16 and 20 recite similar limitations. Bretschneider and Sartore, alone or in combination, do not teach or suggest all the elements of the presently claimed invention. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Specifically, assuming, *arguendo*, the mouse 42 of Bretschneider is similar to the presently claimed first device (as suggested in the last paragraph on page 2 in the Office Action and for which Applicant's representative does not necessarily agree), Bretschneider does not appear to teach or suggest the first device configured to present one or more first control signals **dedicated to** advancing through a plurality of slides presented by an electronic presentation program in response to one or more input instructions, as presently claimed. In particular, Bretschneider appears silent regarding the mouse 42 being configured to present one or more first control signals **dedicated to** advancing through a plurality of slides presented by an electronic presentation program in response to one or more input instructions, as presently claimed.

Furthermore, since Bretschneider discloses a slide presentation program operating in a Microsoft Windows® environment

(see FIGS 3 and 5A-5C of Bretschneider), it does not appear that the mouse 42 is configured to present one or more first control signals **dedicated to** advancing through a plurality of slides presented by an electronic presentation program in response to one or more input instructions, as presently claimed. For example, FIG. 5C of Bretschneider shows that Microsoft Internet Explorer can be installed via the mouse 42.

Sartore does not appear to cure the deficiencies of Bretschneider. Specifically, Sartore appears to be silent regarding a device configured to present one or more first control signals **dedicated to** advancing through a plurality of slides presented by an electronic presentation program in response to one or more input instructions, as presently claimed. Since both Bretschneider and Sartore are silent regarding a device configured to present one or more first control signals **dedicated to** advancing through a plurality of slides presented by an electronic presentation program in response to one or more input instructions, as presently claimed, it follows that Bretschneider and Sartore, alone or in combination, do not teach or suggest all the elements of the presently claimed invention. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

Furthermore, the Office Action fails to provide particular findings as to the reasons a skilled artisan, with no

knowledge of the presently claimed invention, would have selected the cited references for combination. The factual inquiry whether to combine references must be thorough and searching.<sup>1</sup> The rigorous application of the requirement for showing the teaching or motivation to combine references is necessary to avoid the subtle but powerful attraction of a hindsight-based obviousness analysis.<sup>2</sup> The conclusory statement that "it would have been obvious to one of ordinary skill in the art at the [time] the invention was made to have substituted UBS [sic] bus to provide power to the peripheral device as taught by Sartore to the UBS [sic] bus to Bretschneider because UBS [sic] bus of Sartore provided a system for easily altering the configuration data for a peripheral device"<sup>3</sup> does not adequately address the issue of motivation to select or combine.<sup>4</sup> Furthermore, it is improper, in determining whether a person of ordinary skill in the art would have been led to the combination of references, simply to use that which the inventor taught against its teacher.<sup>5</sup> Therefore, because the Office Action fails to provide particular findings as to the reasons a skilled artisan,

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<sup>1</sup> *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001).

<sup>2</sup> *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

<sup>3</sup> See page 4, lines 1-5 of the Office Action dated June 6, 2003.

<sup>4</sup> See *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

<sup>5</sup> *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

with no knowledge of the presently claimed invention, would have selected the cited references for combination,<sup>6</sup> the Office Action does not appear to have met the Office's burden of factually supporting a *prima facie* conclusion of obviousness.<sup>7</sup> As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.<sup>8</sup>

Claims 2-5, 7-15, 17, 19 and 21-23 depend, either directly or indirectly, from claim 1 or claim 16 which are believed to be allowable. New claims 24-27 are believed to be allowable. As such, the presently claimed invention is fully patentable over the cited references and the rejection should be withdrawn.

The rejection of claims 13, 14 and 20 under 35 U.S.C. §103(a) as being unpatentable over Bretschneider in view of Meyn et al. '623 (hereinafter Meyn) has been obviated by appropriate amendment and should be withdrawn.

Bretschneider is directed to a method and apparatus for automatically updating data files in a slide presentation program (Title). Meyn is directed to an intelligent display system presentation projection arrangement and method of using same (Title).

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<sup>6</sup> *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

<sup>7</sup> MPEP §2142.

<sup>8</sup> MPEP §2142.

The combination of Bretschneider and Meyn do not teach each and every element of the presently claimed invention. Specifically, claims 13 and 14 depend, either directly or indirectly, from claim 1 and, therefore, include all the limitations of claim 1. Claim 20 includes similar limitations. In particular, Bretschneider does not appear to teach or suggest either (i) the first device configured to present one or more first control signals **dedicated to** advancing through a plurality of slides presented by an electronic presentation program in response to one or more input instructions or (ii) a bus interface configured to provide power to the device (see last paragraph on page 2 of the Office Action), as presently claimed.

Meyn does not cure the deficiencies of Bretschneider. Specifically, Meyn does not appear to teach or suggest a first device configured to present one or more first control signals **dedicated to** advancing through a plurality of slides presented by an electronic presentation program in response to one or more input instructions, as presently claimed. In particular, Meyn provides:

    Navigating and entering commands, with the remote control device may be accomplished with relatively few keys. The mouse disk and the Forward/Reverse keys. To select a button, checkbox, list box, or any item in a list box, the mouse disc is rotated to highlight the item. **Once in a list box, Forward and Reverse are pressed to select an item.** To click a button or check a checkbox (once selected), the mouse disc is pressed. (column 13, lines 51-56 of Meyn, emphasis added).

Since the Forward and Reverse keys of Meyn are used to select items in a list box, it follows that Meyn does not teach or suggest a first device configured to present one or more first control signals **dedicated to** advancing through a plurality of slides presented by an electronic presentation program in response to one or more input instructions, as presently claimed.

Since neither Bretschneider nor Meyn teach or suggest a device configured to present one or more first control signals **dedicated to** advancing through a plurality of slides presented by an electronic presentation program in response to one or more input instructions, as presently claimed, it follows that Bretschneider and Meyn, alone or in combination, do not teach or suggest all the elements of the presently pending claims 13 and 14. As such, the presently pending claims 13 and 14 are fully patentable over the cited references and the rejection should be withdrawn.

Furthermore, with respect to claims 13 and 14, assuming, *arguendo*, the mouse 42 of Bretschneider is similar to the presently claimed first device and the status dialog of Meyn is similar to the presently claimed alert indicator (as suggested in the last paragraph on page 2 and in lines 4-5 on page 6 of the Office Action and for which Applicant's representative does not necessarily agree), Meyn does not teach or suggest that the first device further comprises an alert indicator, as presently claimed. In particular, the Office Action does not present any evidence or

convincing line of reasoning why one of ordinary skill in the art would consider the status dialogs of Meyn to be part of the mouse 42 of Bretschneider. Therefore, Bretschneider and Meyn, alone or in combination, do not teach or suggest all the elements of the presently pending claims 13 and 14. As such, the presently pending claims 13 and 14 are fully patentable over the cited references and the rejection should be withdrawn.

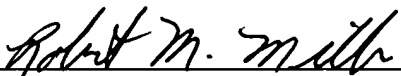
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicants' representative should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

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Dated: September 8, 2003

Docket No.: 0325.00281